

## REMARKS

Upon entry of the present amendment, the claims remaining in the application are claims 22, 26, 29, and 33-39.

A clean copy of the amended claims 22, 26, 29 and 39 are also enclosed herewith.

Amended claim 22 combines the subject matter of previous claims 22, 23 and 24.

Amended claim 26 depends from the amended claim 22, and specifically recites that each of said first, second and third completely-passive parallel resonant circuits is tuned to said third harmonic frequency of said fundamental frequency of said AC source.

Amended claim 29 combines the subject matters of previous claims 29, 30 and 31.

Amended claim 39 now specifically recites that said completely-passive parallel resonant circuit is tuned to a third harmonic frequency of said AC source to change the current drawn by said nonlinear load.

Applicant respectfully submits that the amended claims 21, 26, 29 and 39 are not unpatentable under 35 USC 103(a) over applicant's admitted prior art (APA) in view of Stacey and Thanawala.

Clearly, the Examiner does not contend that the claims as now amended are unpatentable over the APA in view of Stacey alone.

Similarly, it is also clear that the Examiner does not contend that the claims as now amended are unpatentable over the APA in view of Thanawala alone.

Assuming *arguendo* but not conceding that the APA makes a suggestion leading the artisan to look to the 1974 Stacey reference, and assuming *arguendo* but not conceding that the APA makes a suggestion leading the artisan to look to the 1975 Thanawala reference, it is respectfully submitted that the APA makes absolutely no suggestion which would lead artisans to combine the 1974 Stacey reference with the 1975 Thanawala reference.

It is also clear that, even with respect to the appealed claims which are broader than the now-amended claims, “the references of Stacey and Thanawala, standing alone, would not have suggested appellant’s invention to the artisan”. (Appeal No. 1997-1187, decision rendered 7/25/00, see page 4 of the opinion).

Even if the APA itself suggests the combining of the 1974 Stacey reference with the 1975 Thanawala reference (which the APA does not), “It is improper to combine prior art references solely because the inventor’s patent itself suggests the new combination of old elements.” Mitsubishi Electric Corporation v Ampex Corporation, (CAFC, 8/30/1999, No. 97-1502).

Nothing in the APA suggests the combination of the 1974 Stacey reference and the 1975 Thanawala reference. Furthermore, the Examiner has not satisfied the burden of obviousness in light of combination by showing some objective teaching leading to the combination.

As the Court of Appeals for the Federal Circuit stated in *In re Dembiczak* (4/28/1999, No. 98-1498):

Our analysis begins in the text of section 103 quoted above, with the phrase “at the time the invention was made.” For it is this phrase that guards against entry into the “tempting but forbidden zone of hindsight.” see Loctite Corp. v Ultraseal Ltd., 781 F.2d 861, 873, 28 USPQ 90, 98 (Fed. Cir. 1985), overruled on other grounds by Nobelpharma AB v Implant Innovations, Inc., 141 F.3d 1059, 46 USPQ2d 1097 (Fed. Cir. 1998), when analyzing the patentability of claims pursuant to that section. Measuring a claimed invention against the standard established by section 103 requires the oft-difficult but critical step of casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by

the prior art references and the then-accepted wisdom in the field. See, e.g., W.L. Gore & Assoc., Inc. v Garlock, Inc., 721 F2d 1540, 1553, 220 USPQ 303, 313 (Fed. Cir. 1983). Close adherence to this methodology is especially important in the case of less technologically complex inventions, where the very ease with which the invention can be understood may prompt one “to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher.” Id.

Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references. See, e.g. C.R. Bard, Inc. v M3 Sys., Inc., 157 F3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998) (describing “teaching or suggestion or motivation [to combine]” as an “essential evidentiary component of an obviousness holding”); In re Rouffet, 149 F3d 1350, 1359, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998) (“the Board must identify specifically...the reasons one of ordinary skill in the art would have been motivated to select the references and combine them”); In re Fritch, 972 F2d 1260, 1265, 23 USPQ2d 180, 1783 (Fed. Cir. 1992) (examiner can satisfy burden of obviousness in light of combination “only by showing some objective teaching [leading to the combination]”); In re Fine, 837 F2d 1071, 1075, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988) (evidence of teaching or suggestion “essential” to avoid hindsight); Ashland Oil, Inc. v Delta Resins & Refractories, Inc., 776 F2d 281, 297, 227 USPQ 657, 667 (Fed. Cir. 1985) (district court’s conclusion of obviousness was error when it “did not elucidate any factual teachings, suggestions or incentives from this prior art that showed the propriety of combination”). See also Graham, 383 U.S. at 18, 148 USPQ 1t 467 (“strict observance” of factual predicates to obviousness conclusion required). Combining prior art references without evidence of such a suggestion, teaching or motivation simply takes the inventor’s disclosure as a blueprint for piecing together the prior art to defeat patentability - - the essence of hindsight. See, e.g. Interconnect Planning Corp. v Feil, 774 F2d 1132, 1138, 227 USPQ 543, 547 (Fed. Cir. 1985) (“The invention must be viewed not with the blueprint drawn by the inventor, but in the state of the art that existed at the time.”) In this case, the Board fell into the hindsight trap.

It is respectfully submitted that the unobviousness of amended claims 22, 26, 29 and 39 is further supported by the Declaration re. Commercial Success and Acclaim submitted herewith.

As stated by the Court of Appeals for the Federal Circuit in Pro-Mold and Tool Co. v Great Lakes Plastics, Inc., 75 F.3d 1538, 37 USPQ2d 1626 (Fed. Cir. 1996):

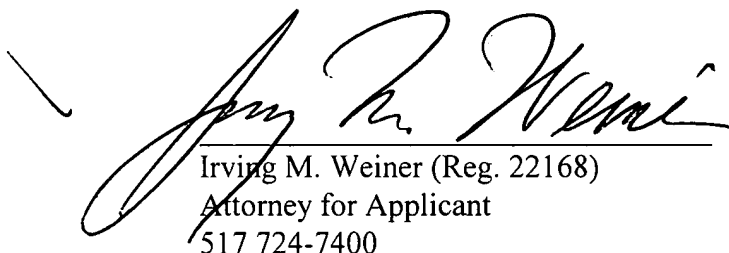
A determination of obviousness under 35 U.S.C. § 103 is a legal conclusion involving factual inquiries. Uniroyal, Inc. v Rudkin-Wiley Corp., 837 F. 2d 1044, 1050, 5 USPQ2d 1434m 1438 (Fed. Cir.) cert. denied, 448 U.S. 825 (1988) Among these factual inquiries are secondary considerations, which include evidence of factors tending to show nonobviousness, such as commercial success of the invention, satisfying a long-felt need, failure of others to find a solution to the problem at hand, and copying of the invention by others. Id.; Panduit Corp. v. Dennison Mft. Co., 810 F2d 1561, 1566, 1 USPQ2d 1593, 1595, (Fed. Cir.) cert. denied 481 U.S. 1052 (1987).

In light of the foregoing, applicant respectfully requests reconsideration of the 35USC103 rejection with a view toward withdrawing same.

In light of the foregoing, and the allowance of claims 33-38, it is respectfully submitted that the application is now in condition for allowance and a notice to this effect is earnestly solicited.

Applicant also encloses herewith a Petition for Extension of Time Under 37 CFR 1.136(a) with the required extension fee. Favorable reconsideration is respectfully requested.

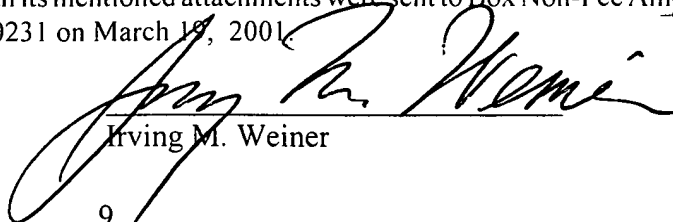
Respectfully submitted,

  
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**Certificate of Mailing**

I hereby certify that the foregoing amendment with its mentioned attachments were sent to Box Non-Fee Amendment, Commissioner for Patents, Washington, D.C. 20231 on March 19, 2001.

  
Irving M. Weiner  
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22. In a multiple phase electrical system for supplying power from an AC source to one or more nonlinear loads connected to at least one phase line therein, a device for substantially eliminating currents in a neutral wire, said device comprising:

a first completely-passive parallel resonant circuit having three passive electrical branches connected in parallel;

said first completely-passive parallel resonant circuit is tuned to a third harmonic frequency of a fundamental frequency of said AC source; and

said three passive electrical branches comprise a first branch consisting of a capacitor, a second branch consisting of a reactor, and a third branch consisting of a resistor.

26. A device according to claim 22, wherein:

each phase line of said multiple phase electrical system supplies power to an associated one of said nonlinear loads;

said device includes a second completely-passive parallel resonant circuit and a third completely-passive parallel resonant circuit;

each of said first, second and third completely-passive parallel resonant circuits is connected along a separate phase line of said multiple phase electrical system in series with at least one of said nonlinear loads whose power is supplied by said separate phase line; and

each of said first, second and third completely-passive parallel resonant circuits is tuned to said predetermined harmonic frequency of said fundamental frequency of said AC source.

1 29. A device for substantially eliminating a predetermined harmonic current generated by a  
2 nonlinear load in an electrical distribution system which distributes power from an AC source,  
3 said device comprising:

4 a completely-passive parallel resonant circuit connected in series with said nonlinear  
5 load;

E3 6 said completely-passive parallel resonant circuit comprises three completely-passive  
7 electrical branches;

8 said completely-passive parallel resonant circuit is tuned to a third harmonic frequency  
9 of a fundamental frequency of said AC source to change the current drawn by said nonlinear  
10 load; and

11 said three completely-passive electrical branches comprise a first branch consisting of a  
12 capacitor, a second branch consisting of a reactor, and a third branch consisting of a resistor.

BOARD  
DECISION

1 39. A device for reducing currents in an electrical system which supplies power to a  
2 nonlinear load from an AC source, comprising:

3 a completely-passive parallel resonant circuit connected in series with said nonlinear  
4 load;

E4 5 said completely-passive parallel resonant circuit comprises three completely-passive  
6 electrical branches;

7 said completely-passive parallel resonant circuit is tuned to a third harmonic frequency of  
8 said AC source to change the current drawn by said nonlinear load;

9 a housing member for said completely-passive parallel resonant circuit; and

10 means for connecting the nonlinear load to said completely-passive parallel resonant  
11 circuit.